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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,420	08/19/2003	Arya Reza Behzad	BP2474	4570
51472	7590	11/16/2006	EXAMINER	
GARLICK HARRISON & MARKISON P.O. BOX 160727 AUSTIN, TX 78716-0727			VO, NGUYEN THANH	
			ART UNIT	PAPER NUMBER
			2618	

DATE MAILED: 11/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/643,420

Applicant(s)

BEHZAD, ARYA REZA

Examiner

Nguyen T. Vo

Art Unit

2618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6-16 is/are allowed.
- 6) ☒ Claim(s) 1-4, 17-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 1, the recitation "the uncompensated local oscillation signal" at line 8 lacks clear antecedent basis. In order to overcome this rejection, it is suggested that the recitation "wherein the input signal comprises a frequency correction input for mixing with the uncompensated local oscillation signal to produce a frequency compensated local oscillation signal" should be changed to --wherein the first mixing stage input signal comprises a frequency correction input for mixing with the first reference signal to produce a local oscillation frequency correction current signal component—in order to be consistent with figure 5 and other independent claims 6 and 12. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 17-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Shi (US 2003/0138032, cited by examiner).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

As to claims 17-21, the claims refer to the embodiment of figure 3 of the present application. Since figure 7 of Shi is the same as figure 3 of the present application, Shi clearly discloses all the claimed limitations.

Still as to claims 17-21 with respect to the newly added limitation of a two-stage local oscillator means, figures 7 and 8 of Shi clearly discloses a two-stage local oscillator means as claimed (see the two mixers in figures 7 and 8). In addition, the upper mixer in figures 7 and 8 reads on a frequency adjustment means as claimed.

5. Claims 17-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Shi (US 2004/0137852, cited by examiner).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in

the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

As to claims 17-21, the claims refer to the embodiment of figure 3 of the present application. Since figure 3 of Shi is the same as figure 3 of the present application, Shi clearly discloses all the claimed limitations.

Still as to claims 17-21 with respect to the newly added limitation of a two-stage local oscillator means, figure 3 of Shi clearly discloses a two-stage local oscillator means as claimed (see the two mixers in figure 3). In addition, the upper mixer in figure 3 reads on a frequency adjustment means as claimed.

6. Claims 17-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Shi (7,020,449, cited by examiner).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

As to claims 17-21, the claims refer to the embodiment of figure 3 of the present application. Since figure 8 of Shi is the same as figure 3 of the present application, Shi clearly discloses all the claimed limitations.

Still as to claims 17-21 with respect to the newly added limitation of a two-stage local oscillator means, figure 8 of Shi clearly discloses a two-stage local oscillator

means as claimed (see the two mixers in figure 8). In addition, the upper mixer in figure 8 reads on a frequency adjustment means as claimed.

7. Claims 17-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Shi (US 2003/0138034, cited by examiner).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

As to claims 17-21, the claims refer to the embodiment of figure 3 of the present application. Since figure 9 of Shi is the same as figure 3 of the present application, Shi clearly discloses all the claimed limitations.

Still as to claims 17-21 with respect to the newly added limitation of a two-stage local oscillator means, figures 9-11 of Shi clearly discloses a two-stage local oscillator means as claimed (see the two mixers in figures 9-11). In addition, the upper mixer in figures 9-11 reads on a frequency adjustment means as claimed.

8. *Since the above applied references have a common assignee with the instant application, they are not prior art under 35 U.S.C. 103.*

9. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Ashby (6,029,060, cited by examiner).

As to claim 1, Ashby discloses in figure 3 a multi-stage mixer module, comprising a transconductance block 302 for receiving an input signal V_{in} having a frequency, the transconductance block for converting the input signal from a voltage to a current to produce a first mixing stage input signal in a current domain (see the voltage-to-current converter 302); a first frequency mixing stage 304 coupled to receive a first reference signal LO1 and the first mixing stage input signal, the first mixing stage producing a second mixing stage input signal in the current domain (see the output of mixer 304), wherein the input signal comprises a frequency correction input (see the output of block 302) for mixing with the uncompensated local oscillation signal LO to produce a frequency compensated local oscillation signal (see the output of block 306); a second frequency mixing stage 310 coupled to receive a second reference signal LO2 and the second mixing stage input signal, the second mixing stage producing a second mixing stage output signal in the current domain (see the output of mixer 310); and an output stage 312 coupled to receive the second mixing stage output signal, the output stage for converting the second mixing stage output signal from the current domain to a voltage domain to produce a mixer module output signal (see the current-to-voltage converter 312). See also column 3 lines 7-46. Ashby thus discloses all the claimed limitations.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ashby.

As to claims 2-3, Ashby fails to disclose the values of the first and second reference signals LO1 and LO2 as claimed. Those skilled in the art, however, would have recognized that the above claimed limitations would not render the claims patentable over Ashby. The reason is that they would merely depend on the operating ranges one would like to operate the multi-stage mixer in. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ashby as claimed, in order to increase the dynamic range of the multi-stage mixer.

Double Patenting

12. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

13. Claims 17-21 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 25-28 and 35 of copending Application No. 10/255,378. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

As to claim 17, it claims the same invention as that of claim 28 of the above copending application.

As to claim 18, it claims the same invention as that of claim 26 of the above copending application.

As to claim 19, it claims the same invention as that of claim 27 of the above copending application.

As to claim 20, it claims the same invention as that of claim 28 of the above copending application.

As to claim 21, it claims the same invention as that of claim 35 of the above copending application.

Allowable Subject Matter

14. Claim 4 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

15. Claims 6-16 are allowed.

Response to Arguments

16. Applicant's arguments filed 9/11/2006 have been fully considered but they are not persuasive.

Regarding the rejections to claims 17-21 under 35 U.S.C. 102(e) over several references to Shi, applicant argues that the applied references fail to disclose a two-stage local oscillator means as claimed. The examiner, however, disagrees. Applicant's attention is directed to the rejections above as to how the newly added

limitation of a two-stage local oscillator means does not render the claims 17-21 patentable over the applied references.

Regarding the rejection to claim 1 under 35 U.S.C. 102(b) over Ashby, applicant states that claim 1 is now allowable because it includes the limitations of claim 5. The examiner, however, disagrees. Since the allowable subject matter in claim 4 is not incorporated in claim 1, claim 1 is still rejected under 35 U.S.C. 102(b) over Ashby.

Applicant in his remarks fails to address the Double Patenting rejection to claims 17-21 over claims 25-28 and 35 of copending application 10/255,378. Accordingly, the Double Patenting rejection is repeated in this action.

Conclusion

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nguyen T. Vo whose telephone number is (571) 272-7901. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban can be reached on (571)272-7899. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nguyen Vo



11-14-2006

NGUYEN T. VO
PRIMARY EXAMINER